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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,252	07/29/2003	John E. Larsen JR.	Case PA-190	5433

7590 02/25/2004

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EXAMINER

MITCHELL, KATHERINE W

ART UNIT PAPER NUMBER

3677

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/628,252

Applicant(s)

LARSON

Examiner

Katherine W Mitchell

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 December 1003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12/15/03. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

Applicant submitted a form PTO-1449 with the same patent number (4721418) attributed to different inventors (Kidera and Queen). Examiner has listed the correct patent number for Kidera on the enclosed form PTO-892.

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

2. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 3677

3. Claims 8-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6616381. Although the conflicting claims are not identical, they are not patentably distinct from each other because they cover a method of installing an anti-jacking pile using a collar and bond breaking material.

***Claim Objections***

4. Claim 1 is objected to because of the following informalities: Line 10 discloses "bond breaking" and is missing the word --material--. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-7 and 12-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 2 and 13 contain the trademark/trade name Permalon™. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or

Art Unit: 3677

trade name. In the present case, the trademark/trade name is used to identify/describe a bond breaking material and, accordingly, the identification/description is indefinite.

8. Claim 12 recites the limitation "said pile" in lines 5-6. There is insufficient antecedent basis for this limitation in the claim. Examiner notes that a pile is cited in the preamble, but section (b) refers to a pipe portion, and examiner believes "said pile" is referring to the pipe. Claims 13-15 are rejected as depending from claim 12.

9. Claims 1, 3 and 14 recite the limitation "said bond breaker" in lines 11, 2 and 2 respectively. There is insufficient antecedent basis for this limitation in the claims.

Claims 2-7 are rejected as depending from claim 1.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**11.** Claims 1, 4, 5, 8, 10, 11, 12, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Howard US Patent 3630037. Howard teaches an anti-jacking pile for supporting a building extending from a predetermined point above ground to a location below ground such that a building can be supported in the abstract and col 1 lines 49-63. A rubberlike sleeve as a bond breaking layer around the pile preventing soil from contacting pile at the portion covered by the bond breaking material is also taught in the abstract and col 1 lines 49-63. A collar or ring (22) thicker than the bond breaking material is taught in Figs 1 and 2 and col 2 lines 35-38 and 51-57, said lower portion of

Art Unit: 3677

ring being welded to the pile below the lower section of the bond breaking sleeve at 26, such that the pile may be driven in the ground without damaging the bond breaking material. Figs. 1 and 2 show the pile is a pipe.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 2 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard in view of Technical report ERDC/CRREL TR-00-9, US Army Corps of Engineers, hereafter called the Technical report. As discussed above, Howard teaches all the elements except that the bond breaking material is Permalon™. Permalon™ as a good low temperature polyethylene for cold weather construction is taught in page 4, col 2, paragraph 2. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Howard to include Permalon™ as the bond breaking material as taught by the Technical report in order to use durable, readily available and proven materials.

14. Claims 3, 9, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard.

Re claims 3 and 14: As discussed above, Howard teaches welding the ring or collar to the pile. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have used a clamp, since the examiner takes

Official Notice of the equivalence of clamping and welding for their use in the connecting materials to circular pipes art and the selection of any of these known equivalents to connect a collar to a pipe would be within the level of ordinary skill in the art.

Re claim 9: Adding a lubricant prior to wrapping the section of the pile with bond breaking material would be obvious in view of the teaching of a lubricant such as napalm thickened arctic diesel fuel is taught in col 2 lines 46-48. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have changed the order and added the lubricant prior to the bond breaking material, since it has been held that that absent any criticality, rearranging parts or steps of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

15. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard in view of Design Standards for Government Facilities, Government of Yukon, hereafter called the Yukon report. As discussed above, Howard teaches all the elements except that the pile is joined to the building with an adjustable leveling system including a steel plate joined to said pile. The Yukon report teaches an adjustable leveling system for piles in arctic use in section 3.4.4 "Pile caps", on page 5 of 7 of the Structural Design Standards of the Yukon Report. Pile caps include a steel plate for joining the pile to the leveling system. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Howard to include an adjustable leveling system connectable to said pile as taught by the Yukon report in order to incorporate a proactive solution to the common problem of long term creep and pile movement.

***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

17. This is a continuing of applicant's earlier Application No. 10/054848. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine W Mitchell whose telephone number is 703-305-6713. The examiner can normally be reached on Mon - Thurs 10 AM - 8 PM.



Art Unit: 3677

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-4180.

Kwm  
2/19/2004



J. J. SWANN  
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